

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

TELCORDIA TECHNOLOGIES, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 04-875 GMS
	)	
LUCENT TECHNOLOGIES, INC.,	)	
	)	
Defendant.	)	
	)	
TELCORDIA TECHNOLOGIES, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 04-876 GMS
	)	
CISCO SYSTEMS, INC.,	)	
	)	
Defendant.	)	
	)	

**ORDER**

WHEREAS, on September 18, 2006, the court held a summary judgment teleconference with the parties;

WHEREAS, during the conference, the parties raised several issues on which the court reserved judgment, including (1) the plaintiff's request to have the court render the defendants' invalidity counterclaims moot; (2) the plaintiff's request to file a motion for summary judgment with respect to the defendants' anticipation and enablement counterclaims; and (3) the defendants' request to file a motion for summary judgment of invalidity for failure to satisfy the best mode requirement;

WHEREAS, after having considered the parties' submissions and arguments, as well as the relevant law,<sup>1</sup> the court concludes that it will exercise its discretion to hear the defendants' counterclaims; and

WHEREAS, the court further concludes that the plaintiff's request to file a motion for summary judgment regarding patent validity on the grounds of anticipation and enablement, and the defendants' request to file a motion for summary judgment of invalidity for failure to satisfy the best mode requirement shall be granted in the interest of justice;

IT IS HEREBY ORDERED that:

1. The plaintiff's request to have the court render the defendants' invalidity counterclaims moot is DENIED.
2. The plaintiff's request to file a motion for summary judgment with respect to the defendants' anticipation and enablement counterclaims is GRANTED.
3. The defendants' request to file a motion for summary judgment of invalidity for failure to disclose the best mode is GRANTED.

Dated: September 20, 2006

/s/ Gregory M. Sleet  
UNITED STATES DISTRICT JUDGE

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<sup>1</sup> See *Liquid Dynamics Corp. v. Vaughan Co.*, 355 F.3d 1361, 1371 (Fed. Cir. 2004) ("A district court judge faced with an invalidity counterclaim challenging a patent that it concludes was not infringed may either hear the claim or dismiss it without prejudice. . . .") (citing *Nystrom v. TREX Co.*, 339 F.3d 1347, 1351 (Fed. Cir. 2003)).